

TTAB

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A Limited Liability Partnership
2 Including Professional Corporations
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6
7
8 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
9 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
10

11 In re the matter of Trademark Application 78/116,976
12 For the mark **OXIUM**
13 Published: February 3, 2004

14 Smithkline Beecham Corporation) Opposition No.: 91/160,810
15)
Opposer)
16)
v.)
17)
18 Therox, Inc.,)
a California corporation,)
19)
Registrant.)
20



02-18-2005

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #64

21
22 **MOTION TO RE-SCHEDULE PROCEEDINGS BASED ON GOOD CAUSE AND**
23 **MOTION TO COMPEL**
24

25
26 Therox, Inc., through its undersigned counsel, requests that the Trademark Trial and
27 Appeal Board (the "Board") grant its motion to re-schedule the proceedings in this matter for a very
28

1 short period based on good cause and grant its motion to compel responses to outstanding
2 discovery.

3
4 Summary of Proceedings

5
6 On June 9, 2004, Opposer filed a notice of opposition to the Applicant's mark OXIMUM,
7 U.S. Serial Number 78/116976 based on Opposer's prior registered mark OXY. A co-pending
8 opposition was subsequently filed on June 23, 2004 by a different company, Yves Saint Laurent
9 Parfums, Opposition No. 91161025. Answers were filed by Applicant to both pending
10 oppositions on July 20, 2004. (See TTAB Notice of Oppositions attached hereto as Exhibits A and
11 B.) On October 28, 2004, Opposer Smithkline Beecham served its first set of interrogatories and
12 first set of document requests to Applicant. (See Exhibits C and D hereto). Applicant sought and
13 obtained an extension of time to respond to such discovery until December 29, 2004, as
14 Applicant's counsel was on extended travel for ongoing litigation throughout November and
15 December 2004. (See Wojciechowski Declaration and Exhibit E hereto.)

16
17 Applicant then prepared and served its timely responses to Opposer's interrogatories and
18 document requests on December 28, 2004. Applicant then prepared and served its first set of
19 document demands and first set of interrogatories on January 7, 2005. (See Exhibit F and G) On
20 January 18, 2004, Opposer advised Applicant that it had received Applicant's discovery responses
21 and requests, but that it would not respond to the Applicant's requests in view of a December 26,
22 2004 discovery cutoff. (See Exhibit H) Applicant's counsel then investigated the matter, and
23 found that the discovery and testimony schedule and dates associated with the co-pending
24 Opposition No. 91161025 (having a discovery cutoff date of January 9, 2005) had been
25 mistakenly associated with the present Opposition No. 91160810 (having a discovery cutoff of
26 December 26, 2004).

1 Applicant's counsel called Opposer's counsel to inform her of this mistake, and requested
2 that Opposer consent to a short, 30-day extension of all scheduled deadlines and Board dates to
3 allow Applicant to receive responses to its discovery requests, in light of Applicant's own
4 substantive and non-evasive responses timely provided to Opposer. Earlier this week, Opposer's
5 counsel advised that Opposer denied such request and Applicant's counsel advised that Applicant
6 would file this motion for relief on good cause.

7
8 Good Cause for Re-Setting Schedule of Proceedings
9

10 There is good cause for re-setting the schedule of these proceedings based on a number of
11 unfortunate circumstances which have contributed to an unintended delay in these proceedings.
12 Throughout 2004, Petitioner's counsel was engaged in trial preparation for a multi-million dollar
13 case currently pending before Judge Ward in the Eastern District of Texas in Marshall, Texas,
14 Case No. 2:03-CV-227, which was set for a jury trial on January 4, 2004. The undersigned
15 counsel was not in her Orange County, California office for a good portion of this time, and was
16 unexpectedly requested to travel to Marshall, Texas throughout November and December 2004 to
17 assist local counsel in these proceedings. (See Declaration of Tawnya Wojciechowski attached
18 hereto as Exhibit A).

19
20 During this time frame, Applicant's counsel advised Opposer's counsel of her absences,
21 and when Opposer's discovery responses were due on November 29, 2004, Opposer's counsel
22 graciously granted a 30 day extension of time for Applicant to provide its discovery responses,
23 which were timely served to Opposer in late December 2004. (See Exhibit E.) Applicant then
24 prepared and served its own discovery requests (interrogatories and document requests) on
25 January 7, 2005, believing that the cutoff date was January 9, 2005. Opposer's counsel advised
26 Applicant's counsel that it had both received Applicant's discovery responses and its discovery
27 requests, but that it was not going to provide responses to Applicant in view of their late service
28 for the discovery cutoff of December 26, 2004.

1 During this same time frame, Applicant's counsel's established secretary left the
2 employment of Sheppard, Mullin, Richter & Hampton LLP, and Petitioner was assigned a
3 temporary secretary in late October 2004 who was unfamiliar with Ms. Wojciechowski's cases,
4 and unfamiliar with proceedings at the Board. Upon investigation, Applicant's counsel discovered
5 that the TTAB schedule for Opposition No. 91161025 had been inadvertently filed and docketed
6 for both Opposition Nos. 91161025 and 91160810, thus appearing to have the same deadlines for
7 discovery and testimony periods in a review of the file. Applicant's counsel has now corrected this
8 mistake, and the current schedule for the present Opposition No. 91160810 is contained in the file
9 for the present opposition.

10
11 To top off the string of misfortune, Petitioner's counsel suffered an accident which required
12 hospitalization and emergency reconstructive surgery, and has had multiple doctor's appointments
13 throughout January which has contributed to the delay in responding to Opposer's letter of January
14 18, 2005. (See Wojciechowski Decl.)

15
16 Based on the above circumstances, there has been an unintended short delay in these
17 proceedings not intended for any prejudicial purposes and the Board is requested to grant an
18 additional, short period within which Petitioner and Registrant can complete their discovery and
19 take testimony. There have been no previous rescheduled dates or any delays in this proceeding to
20 date. Registrant has not been prejudiced by this short delay, and it would be a miscarriage of
21 justice to penalize Registrant for the above circumstances and the inadvertent mistake made by
22 Petitioner's counsel who overlooked the misfiled schedule of these proceedings during this time
23 frame.

24
25 Motion to Compel.

26
27 As Opposer has stated its intent not to respond to Applicant's discovery requests, as a
28 precautionary measure, Applicant requests that the Board reset the discovery cutoff (for a very

1 short period) and require Opposer to provide responses to Applicant's outstanding discovery
2 requests.

3
4 Conclusion

5
6 For the reasons set forth hereinabove, a number of unforeseen circumstances contributed to
7 a very short delay in these proceedings, and the Board is requested to re-set the schedule to
8 accommodate Applicant. Applicant's request does not prejudice Opposer in any way, and in fact,
9 would unduly foreclose Applicant from obtaining discovery necessary for a judgment on the
10 merits of this opposition proceeding.

11
12 Dated: February 11, 2005

13 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

14
15 By 

16 TAWNYA R. WOJCIECHOWSKI
17 650 Town Center Drive, Fourth Floor
18 Costa Mesa, California 92626
19 Telephone: (714) 424-2828
20 Attorneys for Petitioner
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26
27
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1 EXHIBIT A
2 DECLARATION OF TAWNYA WOJCIECHOWSKI

3 I, Tawnya R. Wojciechowski, do hereby declare:

4 1. I am an attorney in the law firm of Sheppard, Mullin, Richter & Hampton LLP
5 ("SMRH"), outside counsel in California for the Applicant Thereox, Inc. I have personal
6 knowledge of the facts stated herein and, if called as a witness, could and would testify
7 competently thereto.
8

9
10 2. There is good cause for re-setting the schedule of these proceedings based on a
11 number of unfortunate circumstances which have contributed to an unintended delay in these
12 proceedings. Throughout late 2004, I was engaged in trial preparation for a multi-million dollar
13 case currently pending before Judge Ward in the Eastern District of Texas in Marshall, Texas,
14 Case No. 2:03-CV-227, which was set for a jury trial on January 4, 2004. I was not in my Orange
15 County, California office for a significant portion of this time, and was unexpectedly requested to
16 travel to Marshall, Texas throughout November and December 2004 to assist local counsel in
17 these proceedings.
18

19 3. My former secretary left the employment of Sheppard, Mullin, Richter & Hampton
20 LLP, and I was assigned a temporary secretary in late October 2004 who was unfamiliar with my
21 cases, and unfamiliar with my current proceedings before the Board. Upon investigation into this
22 matter, I discovered that the TTAB schedule for Opposition No. 91161025 had been inadvertently
23 filed and I had docketed the same deadlines for both Opposition Nos. 91161025 and 91160810,
24 thus appearing to have the same deadlines for discovery and testimony periods in a review of the
25 file. I have now corrected this mistake, and the current schedule for the present Opposition No.
26 91160810 is contained in the file and docketed on my calendar for the present opposition.
27
28

4. To top off the string of misfortune, I had an accident in early January which required hospitalization and emergency reconstructive surgery to rebuild my lower lip and mouth areas. I have had multiple doctor's appointments throughout January which has also contributed to a couple week delay in responding to Opposer's letter of January 18, 2005.

5. Based on the above circumstances, I request a very short period to re-set the discovery cutoff deadline and testimony periods in this matter. A dismissal of these proceedings would create an injustice to Applicant, through no fault of Applicant, where there is no corresponding prejudice caused to Opposer.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that I executed this declaration on February 11, 2005 at Costa Mesa, California.

By: Tawnya R. Wojciechowski

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: June 9, 2004

Opposition No 91160810
Serial No. 78116976

Margaret A. Kivinski
TherOx, Inc.
2400 Michelson Drive
Irvine, CA 92612-1310

SMITHKLINE BEECHAM CORPORATION

v.

TherOx, Inc.

GARY D. KRUGMAN
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037-3202

George Woods, Legal Assistant:

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the Trademark Trial and Appeal Board Manual of Procedure (TBMP), are available at www.uspto.gov.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	June 29, 2004
Discovery period to close:	December 26, 2004
30-day testimony period for party in position of plaintiff to close:	March 26, 2005
30-day testimony period for party in position of defendant to close:	May 25, 2005
15-day rebuttal testimony period for plaintiff to close:	July 09, 2005

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: June 23, 2004

Opposition No 91161025
Serial No. 78116976

MARGARET A. KIVINSKI
THEROX, INC.
2400 MICHELSON DRIVE
IRVINE, CA 92612-1310

Yves Saint Laurent Parfums

v.

TherOx, Inc.

KEITH E. DANISH
KIRKPATRICK & LOCKHART LLP
599 LEXINGTON AVENUE
NEW YORK, NY 10022-6030

George Woods, Legal Assistant:

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available at www.uspto.gov.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	July 13, 2004
Discovery period to close:	January 09, 2005
30-day testimony period for party in position of plaintiff to close:	April 09, 2005
30-day testimony period for party in position of defendant to close:	June 08, 2005
15-day rebuttal testimony period for plaintiff to close:	July 23, 2005

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

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TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

TRW's desk
copy

D & C
11/30/04
T. WOJCIECHOWSKI/0901/OC

02 JH-114179
Docs CLIP

Attorney Ref.: 201091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SMITHKLINE BEECHAM CORPORATION,

Opposer,

v.

THEROX, INC.,

Applicant.

Extension granted -
Response due 12/29/04

Opposition No.: 91/160,810

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure and Trademark Rules 2.116 and 2.120, Opposer hereby requests that Applicant answer separately and fully, in writing and under oath, each of the following interrogatories, and serve such answers on counsel for Opposer within thirty days of service of these interrogatories. Applicant shall supplement and/or amend its responses to the interrogatories in accordance with Rule 26(e) of the Federal Rules of Civil Procedure.

INSTRUCTIONS

1. In answering these interrogatories, please furnish all information currently known or available to you or your attorneys.
2. Please record a separate answer for each interrogatory and interrogatory subpart. Please set forth and identify the source of each answer separately by identifying each person who you know has personal knowledge of the facts or information forming the basis of the answer which you give.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

3. If you contend that any information is protected by privilege, identify the privilege relied on, the persons who have the requested information and any document which contains the information, including for each document:

- a) the type of document;
- b) the author;
- c) the recipients;
- d) the date;
- e) the subject matter;
- f) the basis of the privilege.

4. If you are unable to respond fully to any interrogatory herein, you should respond to the extent possible and provide an explanation as to why a full response is not possible.

5. All interrogatories herein are directed to that information or those documents within your possession, custody or control, or within the possession, custody or control of your agents, servants and employees and, unless privileged, your attorney. They are also directed to those firms, corporations, partnerships, or trusts that you control and to documents in the possession, custody or control of the employees, agents, next friends, trustees, guardians and/or representatives of such entities.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

6. These interrogatories shall be deemed to be continuing. Your attention is directed to Rule 26(e)(2) of the Federal Rules of Civil Procedure which provides as follows:

A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

DEFINITIONS

The following definitions shall apply to these interrogatories and instructions thereto:

1. "You," "Your" or "Applicant" refers to TherOx, Inc. and any affiliates, agents, employees, distributors and representatives.
2. "Opposer" refers to SmithKline Beecham Corporation and any of its employees and representatives.
3. "Document" means that the original and all non-identical copies of any writing of any kind, which is known by you to exist or to have existed or which at any time has been in your possession, custody, or control, including, but not limited to letters, envelopes, forms, affidavits, correspondence, telegraphs, telecopies, telefaxes, paper communications, signed statements, tabulations, charts, memoranda, checks, appointment books, records, proposals, memoranda or other transcripts by mechanical device, by long hand or short hand recording, tape recorded or by electronic or by any other means, computer generated information, computer software, data stored in a computer, intra-office communications, inter-office communications, all summaries of all communications, telephonic or otherwise, microfiche, microfilm, lists, bulletins, calendars, circulars, desk pads, opinions, ledgers, minutes, agreements, journals,

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

diaries, contracts, invoices, balance sheets, telephone messages or other messages, magazines, pamphlets, articles, notices, newspapers, studies, worksheets, telexes, cables and all other graphic materials, writings and instruments, however produced or reproduced. A document includes all documents appended thereto.

4. "Relating to" or "Relate to" means constituting, discussing, mentioning, containing, analyzing, embodying, reflecting, identifying, incorporating, describing, commenting on, referring to, considering, recommending, dealing with or pertaining to in whole or in part.

5. "Identify" with respect to persons means to give, to the extent known, the person's full name, present or last known address and when referring to a natural person, additionally, present or last known place of employment. Once a person has been identified in accordance with this paragraph, only the name of that person need to be listed in response to subsequent discovery requests in the identification of that person.

6. "Identify" with respect to each document means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) the author(s), addressee(s), and recipient(s).

7. "Identify" with respect to oral communications shall mean: (a) the communication medium, i.e., in person or telephonic; (b) the date of each such communication; (c) the full name and current business and residence address of those who were present at each communication; and (d) the substance and nature of each such communication.

8. "Person" means any natural person or any business, legal or governmental agency or association.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
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9. The connectors "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery requests all responses that might otherwise be construed to be outside its scope.

10. "Including" means including without limitation.

11. "Applicant's Mark" means the mark set forth in Serial No. 78/116,976.

12. "Opposer's Marks" means the marks described and listed in paragraph 3 of the Notice of Opposition dated and filed on June 1, 2004.

INTERROGATORIES

INTERROGATORY NO. 1

State the type of business in which Applicant is engaged, and identify any subsidiaries, parent companies or related companies which use Applicant's Mark or any other name or mark in which the term OXIUM appears.

INTERROGATORY NO. 2

Identify the person(s) most knowledgeable about the selection, adoption and application for registration of Applicant's Mark and identify all documents which are relevant to Applicant's selection, adoption and application for registration of Applicant's Mark.

INTERROGATORY NO. 3

Identify the person(s) most knowledgeable about Applicant's plans to use Applicant's Mark in advertising and promotion thereof.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

INTERROGATORY NO. 4

Identify all documents in the possession, custody or control of or otherwise known to Applicant or its counsel which are relevant to Applicant's selection, adoption and use of Applicant's Mark.

INTERROGATORY NO. 5

State whether Applicant has ever received an opinion from its legal counsel or any other person concerning a possible trademark conflict with Opposer, or the absence thereof, arising out of Applicant's adoption, use, or application to register Applicant's Mark.

INTERROGATORY NO. 6

In the answer to the preceding interrogatory is anything other than an unqualified negative, identify: (a) the date on which such an opinion was provided; (b) the person or persons who provided each opinion; (c) all persons to whom the opinion was provided; and (d) all documents in the possession, custody or control or otherwise known to Petitioner which were relevant to the formulation of each opinion.

INTERROGATORY NO. 7

State whether Applicant has conducted or caused to be conducted any inquiry, search, or investigation of the records of the United States Patent and Trademark Office, any state agency (e.g., trademark or trade name records) or any other records and/or publications including but not limited to trade directories, in connection with the selection, adoption, registration, registrability or use of Applicant's Mark.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

INTERROGATORY NO. 8

Describe the circumstances surrounding Applicant's first awareness of Opposer's use of the Opposer's Marks.

INTERROGATORY NO. 9

State all facts and identify all documents supporting Applicant's assertion in its Application Serial No. 76/116,976 that it had, as of the application filing date, a bona fide intention to use Applicant's Mark in commerce in connection with the goods identified in the application.

INTERROGATORY NO. 10

Identify all persons who participated in any way in the preparation of the answers or responses to these interrogatories separately by interrogatory, and state specifically with reference to interrogatory number the area of participation of each such person.

INTERROGATORY NO. 11

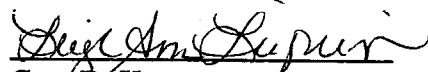
Identify each person which Applicant expects or intends to call as a witness to present evidence in the above captioned opposition proceeding including but not limited to expert witnesses.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

Respectfully submitted,

SMITHKLINE BEECHAM CORPORATION

By:



Gary D. Krugman

Leigh Ann Lindquist

Attorneys for Opposer

SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, DC 20037-3202

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

Date: October 28, 2004

11/29/04. Per telephone conversation with L. Lindquist -
extension granted until 12/29/04.

TRW's desk
copy

D & C
11/30/04
T. WOJCIECHOWSKI for 01/00

02 JH-114179
Docs CLIP

Attorney Ref.: 201091

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SMITHKLINE BEECHAM CORPORATION,

Opposer,

v.

THEROX, INC.,

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1. In answering these interrogatories, please furnish all information currently known or available to you or your attorneys.
2. Please record a separate answer for each interrogatory and interrogatory subpart. Please set forth and identify the source of each answer separately by identifying each person who you know has personal knowledge of the facts or information forming the basis of the answer which you give.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

3. If you contend that any information is protected by privilege, identify the privilege relied on, the persons who have the requested information and any document which contains the information, including for each document:

- a) the type of document;
- b) the author;
- c) the recipients;
- d) the date;
- e) the subject matter;
- f) the basis of the privilege.

4. If you are unable to respond fully to any interrogatory herein, you should respond to the extent possible and provide an explanation as to why a full response is not possible.

5. All interrogatories herein are directed to that information or those documents within your possession, custody or control, or within the possession, custody or control of your agents, servants and employees and, unless privileged, your attorney. They are also directed to those firms, corporations, partnerships, or trusts that you control and to documents in the possession, custody or control of the employees, agents, next friends, trustees, guardians and/or representatives of such entities.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

6. These interrogatories shall be deemed to be continuing. Your attention is directed to Rule 26(e)(2) of the Federal Rules of Civil Procedure which provides as follows:

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1. "You," "Your" or "Applicant" refers to TherOx, Inc. and any affiliates, agents, employees, distributors and representatives.
2. "Opposer" refers to SmithKline Beecham Corporation and any of its employees and representatives.
3. "Document" means that the original and all non-identical copies of any writing of any kind, which is known by you to exist or to have existed or which at any time has been in your possession, custody, or control, including, but not limited to letters, envelopes, forms, affidavits, correspondence, telegraphs, telecopies, telefaxes, paper communications, signed statements, tabulations, charts, memoranda, checks, appointment books, records, proposals, memoranda or other transcripts by mechanical device, by long hand or short hand recording, tape recorded or by electronic or by any other means, computer generated information, computer software, data stored in a computer, intra-office communications, inter-office communications, all summaries of all communications, telephonic or otherwise, microfiche, microfilm, lists, bulletins, calendars, circulars, desk pads, opinions, ledgers, minutes, agreements, journals,

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

diaries, contracts, invoices, balance sheets, telephone messages or other messages, magazines, pamphlets, articles, notices, newspapers, studies, worksheets, telexes, cables and all other graphic materials, writings and instruments, however produced or reproduced. A document includes all documents appended thereto.

4. "Relating to" or "Relate to" means constituting, discussing, mentioning, containing, analyzing, embodying, reflecting, identifying, incorporating, describing, commenting on, referring to, considering, recommending, dealing with or pertaining to in whole or in part.

5. "Identify" with respect to persons means to give, to the extent known, the person's full name, present or last known address and when referring to a natural person, additionally, present or last known place of employment. Once a person has been identified in accordance with this paragraph, only the name of that person need to be listed in response to subsequent discovery requests in the identification of that person.

6. "Identify" with respect to each document means to give, to the extent known: (a) the type of document; (b) the general subject matter; (c) the date of the document; and (d) the author(s), addressee(s), and recipient(s).

7. "Identify" with respect to oral communications shall mean: (a) the communication medium, i.e., in person or telephonic; (b) the date of each such communication; (c) the full name and current business and residence address of those who were present at each communication; and (d) the substance and nature of each such communication.

8. "Person" means any natural person or any business, legal or governmental agency or association.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

9. The connectors "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery requests all responses that might otherwise be construed to be outside its scope.

10. "Including" means including without limitation.

11. "Applicant's Mark" means the mark set forth in Serial No. 78/116,976.

12. "Opposer's Marks" means the marks described and listed in paragraph 3 of the Notice of Opposition dated and filed on June 1, 2004.

INTERROGATORIES

INTERROGATORY NO. 1

State the type of business in which Applicant is engaged, and identify any subsidiaries, parent companies or related companies which use Applicant's Mark or any other name or mark in which the term OXIUM appears.

INTERROGATORY NO. 2

Identify the person(s) most knowledgeable about the selection, adoption and application for registration of Applicant's Mark and identify all documents which are relevant to Applicant's selection, adoption and application for registration of Applicant's Mark.

INTERROGATORY NO. 3

Identify the person(s) most knowledgeable about Applicant's plans to use Applicant's Mark in advertising and promotion thereof.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

INTERROGATORY NO. 4

Identify all documents in the possession, custody or control of or otherwise known to Applicant or its counsel which are relevant to Applicant's selection, adoption and use of Applicant's Mark.

INTERROGATORY NO. 5

State whether Applicant has ever received an opinion from its legal counsel or any other person concerning a possible trademark conflict with Opposer, or the absence thereof, arising out of Applicant's adoption, use, or application to register Applicant's Mark.

INTERROGATORY NO. 6

In the answer to the preceding interrogatory is anything other than an unqualified negative, identify: (a) the date on which such an opinion was provided; (b) the person or persons who provided each opinion; (c) all persons to whom the opinion was provided; and (d) all documents in the possession, custody or control or otherwise known to Petitioner which were relevant to the formulation of each opinion.

INTERROGATORY NO. 7

State whether Applicant has conducted or caused to be conducted any inquiry, search, or investigation of the records of the United States Patent and Trademark Office, any state agency (e.g., trademark or trade name records) or any other records and/or publications including but not limited to trade directories, in connection with the selection, adoption, registration, registrability or use of Applicant's Mark.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

INTERROGATORY NO. 8

Describe the circumstances surrounding Applicant's first awareness of Opposer's use of the Opposer's Marks.

INTERROGATORY NO. 9

State all facts and identify all documents supporting Applicant's assertion in its Application Serial No. 76/116,976 that it had, as of the application filing date, a bona fide intention to use Applicant's Mark in commerce in connection with the goods identified in the application.

INTERROGATORY NO. 10

Identify all persons who participated in any way in the preparation of the answers or responses to these interrogatories separately by interrogatory, and state specifically with reference to interrogatory number the area of participation of each such person.

INTERROGATORY NO. 11

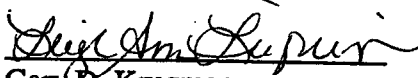
Identify each person which Applicant expects or intends to call as a witness to present evidence in the above captioned opposition proceeding including but not limited to expert witnesses.

OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT
Opposition No. 91/160,810

Respectfully submitted,

SMITHKLINE BEECHAM CORPORATION

By:


Gary D. Krugman
Leigh Ann Lindquist
Attorneys for Opposer
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

Date: October 28, 2004

*11/29/04. Per telephone conversation with L. Lindquist -
extension granted until 12/29/04.*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SMITHKLINE BEECHAM CORPORATION,

Opposer,

v.

THEROX, INC.,

Applicant.

Opposition No.: 91/160,810

**OPPOSER'S FIRST REQUEST OF APPLICANT FOR PRODUCTION OF
DOCUMENTS AND THINGS**

In accordance with the provisions of Rule 34 of the Federal Rules of Civil Procedure and Trademark Rule 2.120, Opposer makes the following requests for the production of documents and things to Applicant. The requested documents and things shall be produced for inspection and copying at the offices of Opposer's counsel, SUGHRUE MION, PLLC, 2100 Pennsylvania Avenue, N.W., Washington, D.C. 20037-3202, or at any other location which is mutually agreeable to the parties, within thirty (30) days from service of these requests.

The definitions and instructions set forth in OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT served concurrently herewith are incorporated herein by reference.

REQUESTS

1. All documents and things identified in response to Opposer's first set of interrogatories to Applicant.
2. All documents which comprise or relate to the results of any search or investigation conducted by or on behalf of Applicant which relate to the availability or registrability of Applicant's Mark.
3. All documents and things supporting Applicant's claim of a bona fide intent to use the mark OXIUM in commerce in connection with the goods described in Applicant's application.
4. All documents and things relating to Applicant's proposed channels of trade, and/or actual channels of trade, to promote, offer and sell its goods under the mark OXIUM.
5. All documents and things relating to Applicant's intended classes of customers and/or actual classes of customers to which the goods under Applicant's mark are offered or intended to be offered.
6. All documents which relate to Opposer's Marks and/or Applicant's first awareness thereof.
7. All documents and things which refer to Opposer.
8. All documents and things which evidence the manner in which Applicant intends to use, and/or uses, its mark in relation to its goods.

Opposer's First Request to Applicant for Production of Documents and Things
Opposition No.: 91/160,810

9. All agreements, and documents relating thereto, which relate in any way to goods sold or to be sold under Applicant's Mark, including but not limited to trademark agreements or licenses.

10. All documents and things supporting Applicant's assertions in paragraphs numbered 1 - 7 of its "Answer to Notice of Opposition" under the title "Affirmative Defenses".

11. All documents or things upon which Applicant intends to rely in this proceeding.

Respectfully submitted,

SMITHKLINE BEECHAM CORPORATION

By:



Gary D. Krugman

Leigh Ann Lindquist

Attorneys for Opposer

SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, N.W.

Washington, DC 20037-3202

Telephone: (202) 293-7060

Facsimile: (202) 293-7860

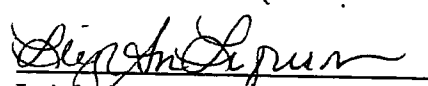
Date: October 28, 2004

Attorney Ref.: 201-091
Oppos. No. 91/160,810

CERTIFICATE OF SERVICE

I, Leigh Ann Lindquist, Esquire, hereby certify that on this 28th day of October, 2004, true and correct copies of the foregoing **OPPOSER'S FIRST SET OF INTERROGATORIES TO APPLICANT** and **OPPOSER'S FIRST REQUEST OF APPLICANT FOR PRODUCTION OF DOCUMENTS AND THINGS** have been properly served, via First Class U.S. Mail, postage prepaid to:

Tawnya R. Wojciechowski, Esq.
SHEPPARD, MULLIN, RICHTER, & HAMPTON LLP
650 Town Center Drive, Fourth Floor
Costa Mesa, California 92626


Leigh Ann Lindquist

11/29/04 Per telephone conversation with
L. Lindquist; extension granted
until 12/29/04.

025H-114179

WOM CLP

Pamela Fowlie

From: Pamela Fowlie
Sent: Tuesday, November 30, 2004 8:39 AM
To: 'llindquist@sughrue.com'
Cc: Tawnya Wojciechowski
Subject: TTAB Opposition No. 91/160,810

Re: TTAB Opposition No. 91/160,810
SmithKline Beecham Corporation vs. Therox, Inc.

Dear Ms. Lindquist:

I am sending this email on behalf of Tawnya Wojciechowski to confirm your telephone conversation of yesterday's date in which you graciously granted us a 30 day extension of time to respond to your discovery requests.

Unless we receive contrary instructions, it is understood that we have until December 29, 2004 to respond to Opposer's First Set of Interrogatories to Applicant and Opposer's First Request of Application for Production of Documents and Things.

Thank you for your cooperation.

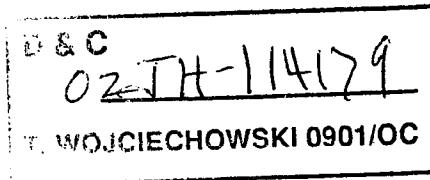
Very truly yours,

Pamela Fowlie
Paralegal to
Tawnya Wojciechowski
Sheppard, Mullin, Richter & Hampton LLP
650 Town Center Drive, Fourth Floor
Costa Mesa, California 92626
Tel: (714) 513-5100
Fax: (714) 513-5130
Email: pfowlie@sheppardmullin.com

DOCKETED

1 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
A Limited Liability Partnership
2 Including Professional Corporations
TAWNYA WOJCIECHOWSKI, Cal. Bar No. 180063
3 650 Town Center Drive, 4th Floor
Costa Mesa, California 92626-1925
4 Telephone: 714-513-5100
Facsimile: 714-513-5130

5 Attorneys for Applicant



6
7
8 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
9 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
10

11
12 In re the matter of Trademark Application No. 78/116,976
For the mark **OXIUM**
13 Published: February 3, 2004

14 Therox, Inc.,) Opposition No. 91/160,810
15 Applicant,)
16 v.)
17 Smithkline Beecham Corporation,)
18 Opposer.)
19

20
21 APPLICANT'S FIRST SET OF DOCUMENT DEMANDS

22 Propounding Party: Applicant Therox, Inc. ("Applicant")

23 Responding Party: Opposer Smithkline Beecham Corporation ("Opposer")

24 Set No.: One
25
26
27
28

1 **APPLICANTS FIRST REQUEST FOR PRODUCTION OF DOCUMENTS**

2 Please take notice that, pursuant to 37 C.F.R. §§ 2.116, 2.120 and Rules 26 and 33
3 of the Federal Rules of Civil Procedure, Therox, Inc. ("Applicant"), hereby requests that
4 Smithkline Beecham Corporation ("Opposer"), within thirty (30) days of service of these
5 requests, produce at the offices of Sheppard, Mullin, Richter & Hampton LLP, 650 Town
6 Center Drive, Fourth Floor, Costa Mesa, California 92626, or at such other location as may
7 be mutually agreed to by the parties, and permit Applicant to inspect and copy, the
8 following documents and things as may be in the possession, custody or control of
9 Opposer.

10
11 **DEFINITIONS**

12
13 The following definitions shall apply:

14
15 1. The term "document" shall mean any and all materials and representations of
16 any kind, on any media, and anything pertaining, describing, relating or referring, directly
17 or indirectly, in whole or in part, to the subject matter of each request herein, including
18 (without limitation):

19 (a) all documents, papers, writings, opinions, file histories, reports, orders, work
20 papers, journals, product packaging, worksheets, letters, correspondence, abstracts,
21 facsimiles, telegrams, telexes, pictures, photographs, films, recorded materials,
22 negatives, slides, plans, charts, diagrams, drawings, blueprints, layouts, memoranda,
23 diaries, time records, books, accounts, notes, notebooks, calendars, records of
24 conversations, computer printouts, punchcard printouts, computer files, e-mail,
25 scripts, publications, contracts, agreements, applications, registrations, certificates,
26 patents, notes, minutes, statements, bills, checks, check stubs, canceled or returned
27 checks, receipts, invoices, advertisements, pamphlets, periodicals, and any written,
28 recorded or other tangible records of any kind, however produced or reproduced,

1 and all drafts, carbon copies, or other writing, typing, printing, photostatic or other
2 forms of communications that are recorded, reproduced or stored electronically as
3 well as all notations and file copies of any of the foregoing;

4 (b) any and all originals and all other copies not absolutely identical;

5 (c) any and all drafts and notes (whether typed or handwritten or otherwise)
6 made or prepared in connection with each such documents, whether used or not;
7 and

8 (d) any and all documents as comprehended within the term "documents" under
9 Rule 34 of the Federal Rules of Civil Procedure.

10 2. The term "file history" shall mean any and all materials and documents
11 pertaining, describing, relating or referring, directly or indirectly, in whole or in part, to
12 any trademarks, service marks, applications, registrations or proceedings which are the
13 subject matter of a request, including (without limitation) any and all applications,
14 application materials, drawings, specimens of use, office actions, office action responses,
15 affidavits, declarations, opposition notices, cancellation petitions, complaints, answers,
16 discovery requests, responses to discovery requests, depositions, motions, and adjudicating
17 body decisions and rulings including, but not limited to, decisions and rulings of the
18 United States Trademark Trial and Appeal Board.

19 3. The term "person" shall mean any natural person, firm, corporation,
20 partnership, proprietorship, group, association, organization, business entity, trust,
21 governmental body, agency and any other form of legal entity and any agent of the
22 foregoing.

23 4. The term "identify" when used with reference to a document or documents,
24 shall mean to state, for each such document:

25 (a) the nature of the document, e.g., letter, memorandum, photograph, etc.; (b)
26 the title or designation of the document;

27 (b) the date of the document;
28

1 (c) the name, title, business affiliation, and business address of all persons who
2 prepared the document;

3 (d) the name, title, business affiliation, and business address of all persons to
4 whom the document was directed;

5 (e) a statement of the subject and substance of the document; (g) the length of
6 the document;

7 (f) a precise description of the place where such document is presently kept,
8 including the title or the description of the file in which such documents would be
9 found and the exact location of such file;

10 (g) the name, title, business affiliation, and business address of each person who
11 presently has custody of such document.

12 5. The term "identify" when used with reference to persons shall mean to state,
13 for each such person their full name, current business affiliation, title, and current business
14 address, or if the current business address is unknown, then the last known business
15 address.

16 6. The terms "and" and "or" shall mean either the conjunctive or the disjunctive
17 as the context may require so that the document request is inclusive rather than exclusive.
18 Pronouns and nouns shall refer to the masculine, feminine, neuter, singular or plural as the
19 context may permit.

20 7. The terms "You" or "Opposer" shall mean Opposer Smithkline Beecham
21 Corporation, the Opposer in the subject proceeding, as well as any subsidiaries, affiliates,
22 partners, joint venturers, directors, officers, employees, principals, agents, attorneys,
23 successors in interest and all persons under its control.

24 25 INSTRUCTIONS

26 1. You shall produce all documents in a form that renders the documents
27 susceptible to copying. You shall produce all documents according to the specific request
28

1 to which the documents are responsive as they are kept in the usual course of business or
2 organized and labeled to correspond to the following requests.

3 2. If you are unable to comply fully with any request herein, you shall comply
4 to the extent possible and provide an explanation as to why full compliance is not possible.

5 3. If any document responsive to or falling within the scope of any request
6 herein is unavailable because it has been destroyed, you shall identify the document, state
7 when the document was destroyed, state the reasons for destruction of the document,
8 identify all persons who ordered the document destroyed and all persons who participated
9 in or have knowledge of the destruction.

10 4. All requests herein are directed to those documents which are in your
11 possession, custody or control, or within the possession, custody or control of your
12 employees, agents, servants, trustees, guardians, attorneys and representatives. They are
13 also directed to those persons that you control, and to documents in possession, custody or
14 control of employees, agents, servants, trustees, guardians, attorneys and representatives of
15 such persons.

16 5. If you withhold, on the basis of a claim of privilege, work product, or any
17 other ground, any document responsive to or falling within the scope of any request herein,
18 you shall identify such document in writing, state all grounds alleged for withholding the
19 document and identify all persons who have or have had possession, custody or control of
20 the document or any portions thereof.

21 6. This request shall be deemed to be continuing. Your attention is directed to
22 Rule 26(e)(2) of the Federal Rules of Civil Procedure, which provides as follows:

23 A party is under a duty seasonably to amend a prior response to
24 an interrogatory, request for production, or request for
25 admission if the party learns that the response is in some
26 material respect incomplete or incorrect and if the additional
27 corrective information has not otherwise been made known to
28 the other parties during the discovery process or in writing.

1 **DOCUMENTS AND THINGS TO BE PRODUCED**

2
3 **REQUEST FOR PRODUCTION NO. 1:**

4 All documents relating or referring to any intention by Opposer to use the mark
5 OXY in commerce in connection with the goods claimed in Application Serial No.
6 78/116,976.

7
8 **REQUEST FOR PRODUCTION NO. 2:**

9 All documents relating or referring to any actual use by Opposer of the mark OXY
10 in commerce in connection with the goods claimed in Application Serial No.: 78/116,976.

11
12 **REQUEST FOR PRODUCTION NO. 3:**

13 All documents and file histories relating or referring to any federal or state
14 trademark applications prepared, submitted or filed by (or on behalf of) Opposer, to
15 register the OXY mark.

16
17 **REQUEST FOR PRODUCTION NO. 4:**

18 All trademark searches conducted by Opposer relating to any registration or
19 enforcement of its mark OXY in the United States.

20
21 **REQUEST FOR PRODUCTION NO. 5:**

22 All documents relating or referring to any use of the mark OXY by any parent or
23 subsidiary entities of Opposer or any entities affiliated with Opposer, including documents
24 relating or referring to the relationship between any such parent, subsidiary and affiliated
25 entities, and Opposer.

1 **REQUEST FOR PRODUCTION NO. 6:**

2 All documents relating or referring to any goods or services marketed, promoted or
3 provided by Opposer in connection with the OXY mark.
4

5 **REQUEST FOR PRODUCTION NO. 7:**

6 All packaging, tags and labels for any goods marketed, promoted or provided by
7 Opposer in connection with the OXY mark.
8

9 **REQUEST FOR PRODUCTION NO. 8:**

10 All marketing, advertising or promotional materials for any services marketed,
11 promoted or provided by Opposer in connection with the OXY mark.
12

13 **REQUEST FOR PRODUCTION NO. 9:**

14 All documents relating or referring to prices charged by Opposer for any goods or
15 services marketed, promoted or provided by Opposer in connection with the OXY mark.
16

17 **REQUEST FOR PRODUCTION NO. 10:**

18 All documents relating or referring to or identifying customers, end-users or
19 recipients of any goods or services marketed, promoted or provided by Opposer in
20 connection with the OXY mark.
21

22 **REQUEST FOR PRODUCTION NO. 11:**

23 All documents relating or referring to news or press releases for the OXY mark or
24 any goods or services marketed, promoted or provided by Opposer in connection with the
25 OXY mark.
26
27
28

1 **REQUEST FOR PRODUCTION NO. 12:**

2 All documents relating or referring to any contracts, business arrangements,
3 licenses, transactions or dealings between Opposer and any third party relating to the OXY
4 mark.

6 **REQUEST FOR PRODUCTION NO. 13:**

7 All Internet and World Wide Web documents relating or referring to products or
8 services marketed, promoted or offered by Opposer in connection with the OXY mark.

10 **REQUEST FOR PRODUCTION NO. 14:**

11 All documents relating or referring to any competitors of Opposer, or any products
12 or services competing with products or services marketed, promoted or offered by Opposer
13 in connection with the OXY mark.

15 **REQUEST FOR PRODUCTION NO. 15:**

16 All documents identifying the persons who participated in the creation,
17 development, design, selection or adoption of the OXY mark.

19 **REQUEST FOR PRODUCTION NO. 16:**

20 All documents relating or referring to the reasons that Opposer selected the term
21 OXY to identify goods or services of Opposer.

23 **REQUEST FOR PRODUCTION NO. 17:**

24 All documents relating or referring to common law rights of Opposer to the OXY
25 mark.

1 **REQUEST FOR PRODUCTION NO. 18:**

2 All documents relating or referring to any instances of actual confusion between the
3 OXIUM mark of Applicant and the OXY mark of Opposer.

5 **REQUEST FOR PRODUCTION NO. 19:**

6 All documents relating or referring to any likelihood of confusion between the
7 OXIUM mark of Applicant and the OXY mark of Opposer.

9 **REQUEST FOR PRODUCTION NO. 20:**

10 All documents relating or referring to the strength of OXY mark as used by
11 Opposer in connection with all goods and services offered under the mark OXY

13 **REQUEST FOR PRODUCTION NO. 21:**

14 All documents relating or referring to acquired distinctiveness or secondary
15 meaning for the OXY mark as used by Opposer.

17 **REQUEST FOR PRODUCTION NO. 22:**

18 All documents relating or referring to any goodwill associated with the OXY mark
19 as used by Opposer.

21 **REQUEST FOR PRODUCTION NO. 23:**

22 All documents relating or referring to any similarity between the goods and services
23 marketed, promoted, offered or provided by Applicant and the goods and services
24 marketed, promoted, offered or provided by Opposer.

1 **REQUEST FOR PRODUCTION NO. 24:**

2 All trademark search reports and other documents relating or referring to any
3 trademark, service mark, or trade name searches, by or for Opposer in connection with the
4 OXY or OXIUM marks.

6 **REQUEST FOR PRODUCTION NO. 25:**

7 All documents relating or referring to any alteration made in the format (e.g.,
8 appearance or spelling) of the OXY mark as a result of information derived by Opposer
9 from a trademark, service mark or trade name search.

11 **REQUEST FOR PRODUCTION NO. 26:**

12 All documents relating or referring to any opinions or analyses, legal or otherwise,
13 regarding the rights of Opposer in its OXY mark, or any mark Opposer believes is/was
14 likely to be confused with Opposer's OXY mark.

16 **REQUEST FOR PRODUCTION NO. 27:**

17 All documents relating or referring to any research, surveys or studies, including but
18 not limited to marketing, purchaser and brand awareness studies, that Opposer has
19 conducted, requested or obtained to determine the familiarity of the public, industry, or any
20 segment thereof, with goods and services promoted by Applicant or Opposer.

22 **REQUEST FOR PRODUCTION NO. 28:**

23 All documents relating or referring to the opinions, advice, reports, studies, facts, or
24 information provided by any persons contacted by or on behalf of Opposer as experts in
25 any capacity in connection with the subject opposition proceeding.

1 **REQUEST FOR PRODUCTION NO. 29:**

2 All documents relating or referring to trademark and service mark licenses,
3 assignments or contracts between Opposer and other persons involving the OXY mark or
4 any mark Opposer believes is/was likely to be confused with Opposer's OXY mark.
5

6 **REQUEST FOR PRODUCTION NO. 30:**

7 All documents relating or referring to any licensing of the OXY mark between
8 Opposer and parent, subsidiary and affiliated entities of Opposer.
9

10 **REQUEST FOR PRODUCTION NO. 31:**

11 All documents relating or referring to any demand or request by (or on behalf of)
12 Opposer that any person cease using the mark OXY or any mark Opposer believes is/was
13 likely to be confused with Opposer's OXY mark.
14

15 **REQUEST FOR PRODUCTION NO. 32:**

16 All documents and file histories relating or referring to any disputes, proceedings,
17 litigation or arbitration between Opposer and any other persons involving the OXY mark
18 or a similar mark.
19

20 **REQUEST FOR PRODUCTION NO. 31:**

21 All documents relating or referring to or establishing Opposer's dates of first use
22 and dates of first use in interstate commerce of the OXY mark, including (without
23 limitation) the documents that Opposer relied upon to establish its dates of first use and
24 first use in interstate commerce for the OXY marks as registered in any registration at the
25 United States Patent and Trademark Office.
26
27
28

1 **REQUEST FOR PRODUCTION NO. 32:**

2 All documents relating or referring to or establishing continuous use by Opposer of
3 the OXY mark since the alleged dates of first use anywhere and first use in interstate
4 commerce.

6 **REQUEST FOR PRODUCTION NO. 33:**

7 All documents relating or referring to any period of time when Opposer ceased use
8 of the OXY mark on any goods or services since the alleged dates of first use.

10 **REQUEST FOR PRODUCTION NO. 34:**

11 All documents relating or referring to the channels of distribution where the goods
12 or services provided by Opposer in connection with the OXY mark are sold.

14 **REQUEST FOR PRODUCTION NO. 35:**

15 All documents referenced, mentioned, described or identified in response to any of
16 the interrogatories set forth in Applicant's First Set of Interrogatories.


18 **REQUEST FOR PRODUCTION NO. 36:**

19 All documents referred to or consulted in responding to any of the interrogatories
20 set forth in Applicant's First Set of Interrogatories.

22 DATED: January 7, 2004

23 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

25 By

26 
TAWNYA WOJCIECHOWSKI
Attorneys for Applicant
Therox, Inc.

CERTIFICATE OF SERVICE

I, the undersigned, certify that I am, and was at the time of service of the papers herein referred to, employed in the County of Orange; over the age of eighteen years and not a party to the within entitled action or proceeding. My business address is 650 Town Center Drive, 4th Floor, Costa Mesa, California 92626-1925.

On **January 7, 2005**, I served the following document(s) described as:

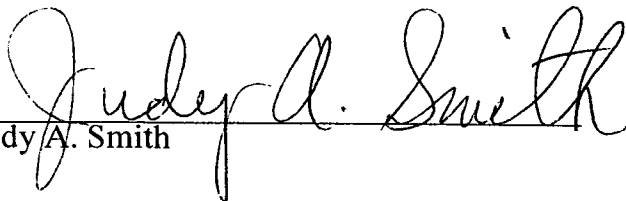
APPLICANT'S FIRST SET OF DOCUMENT DEMANDS

on the interested party(ies) in this action by placing ☒ true copies/☐ originals thereof enclosed in sealed envelopes and/or packages addressed as follows:

Leigh Ann Lindquist
Sughrue Mion PLLC
2100 Pennsylvania Avenue, NW
Washington, D.C. 20037-3202

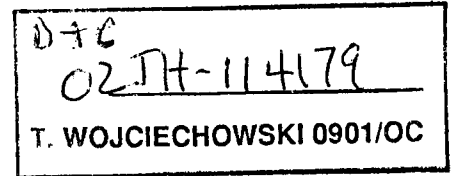
- ☐ **BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. postal service on that same day with postage thereon fully prepaid at Costa Mesa, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.
- ☒ **BY OVERNIGHT DELIVERY:** I served such envelope or package to be delivered on the same day to an authorized courier or driver authorized by the overnight service carrier to receive documents, in an envelope or package designated by the overnight service carrier.
- ☐ **FEDERAL:** I certify under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on **January 7, 2005**, at Costa Mesa, California.


Judy A. Smith

1 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
2 A Limited Liability Partnership
3 Including Professional Corporations
4 TAWNYA WOJCIECHOWSKI, Cal. Bar No. 180063
5 650 Town Center Drive, 4th Floor
6 Costa Mesa, California 92626-1925
7 Telephone: 714-513-5100
8 Facsimile: 714-513-5130

9 Attorneys for Applicant



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re the matter of Trademark Application No. 78/116,976
For the mark **OXIUM**
Published: February 3, 2004

Therox, Inc.,)	Opposition No. 91/160,810
Applicant,)	
v.)	
Smithkline Beecham Corporation,)	
Opposer.)	
_____)	
)	
)	

APPLICANT'S FIRST SET OF INTERROGATORIES

Propounding Party: Applicant Therox, Inc. ("Applicant")

Responding Party: Opposer Smithkline Beecham Corporation ("Opposer")

Set No.: One

DC 2-11-05 ATTY TMM DATE 11/2/04
DOCUMENT NUMBER 6
continued at 4

1 Applicant requests, pursuant to Rule 2.120 of the Trademark Rule of Practice of the
2 U.S. Patent and Trademark Office and the Federal Rules of Civil Procedure, Rule 33 that
3 Opposer separately and fully answer the following interrogatories, and that such
4 admissions or denials be verified under oath and served on all parties within thirty
5 (30) days after service.

6 7 INSTRUCTIONS

8 1. In each instance where an interrogatory is answered on information and belief,
9 Applicant requests that Opposer set forth the basis for such information and belief.

10
11 2. In each instance where Opposer denies knowledge or information sufficient to
12 answer the interrogatory, Applicant requests that Opposer set forth the name and address
13 of each person, if any, known to have such knowledge.

14
15 3. In each instance where the existence of a document is disclosed, Opposer is
16 requested to attach a copy of the document to its responses to these interrogatories. If such
17 document is not in Opposer's possession or control, Applicant requests that Opposer set
18 forth the name and address of each person known to Opposer to have such possession or
19 control, and identify such documents that are in such person's possession or control.

20
21 4. These interrogatories shall be deemed continuing so as to require supplemental
22 answers if Opposer obtains any further information between the time the answers or
23 responses hereto are served and the time of trial.

24 25 DEFINITIONS

26 1. YOU. As used herein, the term "YOU" refers to Opposer Smithkline
27 Beecham Corporation and any predecessors or assignees in name or interest, and any
28

1 person acting at its direction or on its behalf including without limitation any employees,
2 agents, officers, directors, or other representatives.

3
4 2. Applicant. As used herein, the term "Applicant" refers to Applicant Therox,
5 Inc. and any predecessors in name or interest, and any person acting at its direction or on
6 its behalf including without limitation any employees, agents, officers, directors, or other
7 representatives.

8
9 3. OXYGENATED SKIN CARE PREPARATIONS. As used herein, the term
10 "OXYGENATED SKIN CARE PREPARATIONS " is defined as any oxygenated skin
11 care products, namely creams, masks, gels and lotions for the face, hands, feet and body,
12 not including acne products."

13
14 4. IDENTIFY. As used herein, the term IDENTIFY,
15 (a) when used in reference to an oral statement, shall be deemed to mean: State the
16 name of the speaker, the date of the statement, the place at which the statement was made,
17 the person or persons to whom the statement was addressed, if practicable; otherwise a
18 general description of the persons to whom the statement was addressed, the subject matter
19 of the statement; and if the statement was memorialized in a writing or mechanical or other
20 recording, including electronic transmissions, state the date and present location of the
21 writing or other recording;

22
23 (b) when used in connection with a written statement, shall be deemed to mean: state
24 the name of the author, the type of document or writing; the date; the addressee; the
25 subject matter; and the present location thereof. In lieu of such identification, Opposer
26 may attach a copy of the writing containing the written statement and refer to it in its
27 response
28

1 (c) when used in connection with an individual, shall be deemed to mean: state the
2 name; present business and personal addresses; present employer (if self-employed, state
3 so); position or title held; and if the interrogatory refers to a previous period of time, give
4 the above information as if it existed at the time covered by the interrogatory; and
5

6 (d) when used in connection with a document, shall be deemed to mean and included
7 any written recorded or graphic matter, however reproduced, including, but not limited to,
8 any statement contained in books, records, memorandum, agreements, communications,
9 reports, correspondence, facsimiles, telephone calls, summaries of telephone conversations
10 or personal conversations or interviews, graphs, statistics, minutes or records of meetings
11 or conferences, reports or summaries of investigations or audits, opinions of counsel,
12 consultants, investigators or others; brochures, pamphlets, advertisements, circulars,
13 electronic advertisements, internet web sites, original or preliminary notes, drafts of any
14 documents and marginal comments appearing on any document; notes, papers and other
15 writings, whether originals or copies or maintained in electronic form, of any nature, kind
16 or description; and any other physical or tangible objects, including without limitation
17 photographs and recordings, on or in which is recorded any information, or any other
18 writing known to you or in your possession, custody or control.
19

20 5. Trademark. As used herein, the term "trademark" includes trademarks, service
21 marks and trade names, unless a contrary meaning is clear from the context.
22

23 6. OXY. As used herein, the term "OXY" includes those trademarks and service
24 marks, and trade names allegedly owned by Opposer incorporating the term OXY,
25 including U.S. Trademark Registration Numbers 1,869,207, 1,873,555, 2,093,711,
26 1,141,969, and 2,582,225 and any common law rights appurtenant thereto.
27
28

1 INTERROGATORIES

2 INTERROGATORY NO. 1:

3 IDENTIFY each and every product sold or service rendered by YOU under the mark
4 OXY.

5
6 INTERROGATORY NO. 2:

7 IDENTIFY how the mark OXY is used on each product or service rendered by YOU.

8
9 INTERROGATORY NO. 3:

10 For each type of product sold or service rendered that YOU have ever used the mark OXY
11 in connection with, IDENTIFY the specific geographic area (defined as state, county, city,
12 or region) where YOU have sold such product or offered such service.

13
14 INTERROGATORY NO. 4:

15 IDENTIFY what channels of trade each of YOUR products sold or services rendered
16 under the mark OXY were offered, including the manner in which each of the products or
17 services reached YOUR customers (including potential customers), and the geographic
18 reach of each channel of trade.

19
20 INTERROGATORY NO. 5:

21 List the dates when YOU first used the mark OXY.

22
23 INTERROGATORY NO. 6:

24 List any marks incorporating the term OXY which YOU have registered (federal or state).

1 INTERROGATORY NO. 7:

2 IDENTIFY all the media (including advertisements, sales promotional materials,
3 newspapers, magazines, radio, television, catalogs, brochures) in which products sold or
4 services rendered by YOU under the mark OXY were first advertised.

5
6 INTERROGATORY NO. 8:

7 IDENTIFY all the media (including advertisements, sales promotional materials,
8 newspapers, magazines, radio, television, catalogs, brochures) in which each product sold
9 or services rendered by YOU under the mark OXY has ever been advertised.

10
11 INTERROGATORY NO. 9:

12 IDENTIFY all persons (past or present employee or outside contractor) responsible for the
13 promotion (including advertisements, sales promotional materials, newspapers, magazines,
14 radio, television, catalogs, brochures or pamphlets) for any product sold or service
15 rendered by YOU under the mark OXY.

16
17 INTERROGATORY NO. 10:

18 IDENTIFY the amount, by calendar quarter, of money spent to date for the promotion
19 (including advertisements, sales promotional materials, newspapers, magazines, radio,
20 television, catalogs, brochures) of any product sold or services offered to the public by
21 YOU under the mark OXY.

22
23 INTERROGATORY NO. 11:

24 IDENTIFY all entities (including individual persons, any business, partnership,
25 corporation, limited liability companies, or joint ventures) which have been granted any
26 right by YOU to use the OXY mark (including license agreements, distributor agreements,
27 joint venture agreements, consent agreements or other forms of contracts).

1 INTERROGATORY NO. 12:

2 IDENTIFY all persons (including past or present employee or outside contractor)
3 responsible for granting any rights to any other entity (including individual persons, any
4 business, partnership, corporation, limited liability companies, or joint ventures) to use the
5 OXY mark.

6
7 INTERROGATORY NO. 13:

8 IDENTIFY all entities (including individual persons, any business, partnership,
9 corporation, limited liability companies, or joint ventures) known by YOU to have used
10 any mark incorporating the letters "oxy."

11
12 INTERROGATORY NO. 14:

13 IDENTIFY all OXYGENATED SKIN CARE PREPARATIONS ever sold by YOU under
14 the mark OXY.

15
16 INTERROGATORY NO. 15:

17 IDENTIFY (by annual dollar amount and units) the sales volume of each sku of
18 OXYGENATED SKIN CARE PREPARATIONS sold by YOU bearing the letters "oxy."

19
20 INTERROGATORY NO. 16:

21 IDENTIFY all entities (including individual persons, any business, partnership,
22 corporation, limited liability companies, or joint ventures) known by YOU to use a name
23 (including trademark, service mark, or trade name) incorporating the letters "oxy."

24
25 INTERROGATORY NO. 17:

26 IDENTIFY each product ever sold under the mark OXY.

27

28

1 INTERROGATORY NO. 18:

2 IDENTIFY in detail the circumstances (including place, manner of use, method of use, and
3 extent of use) where YOU have sold products under the OXY mark.

4
5 INTERROGATORY NO. 19:

6 IDENTIFY all other entities using marks incorporating the letters "oxy" that you have
7 previously opposed or sent any cease and desist letter to.

8
9 INTERROGATORY NO. 20:

10 IDENTIFY all of YOUR customers during the time period 2001 to the present (by name,
11 address, date, quantity and dollar value purchased who have purchased any product or
12 service from YOU bearing the mark OXY.

13
14 INTERROGATORY NO. 21:

15 Do YOU contend that the mark OXIUM is likely to be confused with the mark OXY? If
16 so, please state all facts upon which such contention is based.

17
18 INTERROGATORY NO. 22:

19 IDENTIFY all instances of actual confusion between the mark OXIUM and YOUR mark
20 OXY.

21
22 INTERROGATORY NO. 23:

23 State the type of business in which Opposer is engaged, and identify any subsidiaries,
24 parent companies or related companies which use Opposer's OXY mark.

1 INTERROGATORY NO. 24:

2 IDENTIFY the person(s) most knowledgeable about the use of Opposer's OXY mark,
3 including but not limited to the strength of Opposer's OXY mark in United States
4 commerce.

5
6 INTERROGATORY NO. 25:

7 IDENTIFY the person(s) most knowledgeable about the marketing efforts of Opposer for
8 products sold under the OXY mark.

9
10 INTERROGATORY NO. 26:

11 IDENTIFY all documents in the possession, custody or control of or otherwise known to
12 Opposer which are relevant to Opposer's selection, adoption and use of Opposer's OXY
13 mark.

14
15 INTERROGATORY NO. 27:

16 IDENTIFY each person that Opposer intends or expects to call as a witness to present
17 evidence in the above captioned opposition proceeding, including but not limited to expert
18 witnesses.

19
20 INTERROGATORY NO. 28:

21 IDENTIFY all Oppositions, Cancellations, cease and desist letters, or other enforcement
22 activities (whether successful or unsuccessful) of Opposer relating to the OXY mark.

23
24 INTERROGATORY NO. 29:

25 IDENTIFY each person who prepared (including assistance in the preparation) of the
26 responses to these interrogatories.


1 INTERROGATORY NO. 30:

2 IDENTIFY all documents utilized in formulating responses to these interrogatories.

3
4 DATED: January 7, 2004

5 SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

6
7 By


for TAWNYA WOJCIECHOWSKI
Attorneys for Applicant
Therox, Inc.

CERTIFICATE OF SERVICE

I, the undersigned, certify that I am, and was at the time of service of the papers herein referred to, employed in the County of Orange; over the age of eighteen years and not a party to the within entitled action or proceeding. My business address is 650 Town Center Drive, 4th Floor, Costa Mesa, California 92626-1925.

On **January 7, 2005**, I served the following document(s) described as:

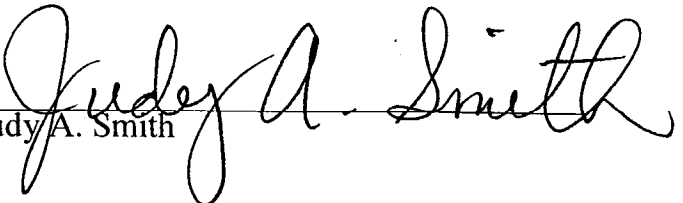
APPLICANT'S FIRST SET OF INTERROGATORIES

on the interested party(ies) in this action by placing ☒ true copies/☐ originals thereof enclosed in sealed envelopes and/or packages addressed as follows:

LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE, NW
WASHINGTON, D.C. 20037-3202

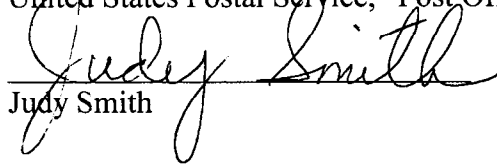
- ☐ **BY MAIL:** I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. postal service on that same day with postage thereon fully prepaid at Costa Mesa, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.
- ☒ **BY OVERNIGHT DELIVERY:** I served such envelope or package to be delivered on the same day to an authorized courier or driver authorized by the overnight service carrier to receive documents, in an envelope or package designated by the overnight service carrier.
- ☐ **FEDERAL:** I certify under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed on **January 7, 2005**, at Costa Mesa, California.


Judy A. Smith

CERTIFICATE OF MAILING BY U.S. MAIL

I hereby certify that this Response is addressed to the Commissioner of Trademarks, Box TTAB Fee, 2900 Crystal Drive, Arlington, VA 22202-3513, and is being deposited with the United States Postal Service, "Post Office to Addressee" for pick up on **February 11, 2005**


Judy Smith

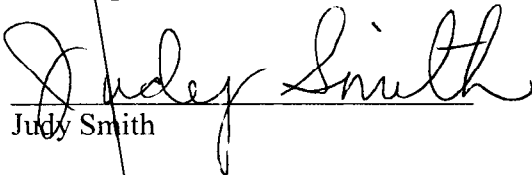
February 11, 2005

Date

CERTIFICATE OF SERVICE BY US MAIL

I hereby certify that on February 11, 2005 a copy of the **MOTION TO RE-SCHEDULE PROCEEDINGS BASED ON GOOD CAUSE AND MOTION TO COMPEL** was served on counsel by depositing a true and correct copy thereof in the United States mail in a sealed envelope with postage thereon fully prepaid, addressed as follows:

Gary D. Krugman
Leigh Ann Lindquist
Sughrue Mion, PLLC
2100 Pennsylvania Ave., NW
Washington, D.C. 20037


Judy Smith

February 11, 2005

Date

**FAX**

Date January 18, 2005

To Tawnya Wojciechowski

Of SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

Fax 714-513-5130

From Leigh Ann Lindquist

Subject SmithKline Beecham v. TherOx, Inc.

Our Ref 201091 Your Ref 02JH-103871

Pages 2
(including cover sheet)

Please call attention to problems with this transmission by return fax or telephone. Thank you.

THE INFORMATION CONTAINED IN THIS COMMUNICATION IS CONFIDENTIAL, MAY BE ATTORNEY-CLIENT PRIVILEGED, AND IS INTENDED ONLY FOR THE USE OF THE ADDRESSEE. UNAUTHORIZED USE, DISCLOSURE OR COPYING IS STRICTLY PROHIBITED AND MAY BE UNLAWFUL. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE IMMEDIATELY NOTIFY US.



Leigh Ann Lindquist
T (202) 663-7409
llindquist@sughrue.com

January 18, 2005
VIA FACSIMILE

Confirmation via U.S. Mail

Tawnya Wojciechowski
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
650 Town Center Drive
4th Floor
Costa Mesa, Ca 92626-1993

Re: *SmithKline Beecham v. TherOx, Inc.*
Opposition No.: 91/160,810
Mark: OXIUM
Your Ref.: 02JH-103871
Our Ref.: 201091

Dear Tawnya:

We are in receipt of your responses to our document requests. We have not yet had an opportunity to review those but will do so shortly.

We are also in receipt of your discovery requests of our client which were served on January 7, 2005. Please note that discovery closed in the above-referenced opposition on December 26, 2004. Accordingly, you served discovery outside of the discovery period. We do not intend to respond to the discovery requests.

Very truly yours,

Leigh Ann Lindquist

LAL/kcl



4th Floor | 650 Town Center Drive | Costa Mesa, CA 92626-1993
714-513-5100 office | 714-513-5130 fax | www.sheppardmullin.com

Tawnya Wojciechowski
714-424-2828
tawnya@sheppardmullin.com

February 11, 2005

Our File Number: 02JH-103871

VIA U.S. MAIL

BOX TTAB/NO FEE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Re: Motion to Re-Schedule Proceedings Based on Good Cause and Motion to
Compel
Opposition No. 91/160,810
Applicant: TherOx, Inc.
Opposer: Smithkline Beecham Corporation

Dear Sir or Madam:

Enclosed for filing are the following papers regarding the above referenced
trademark registration:

1. Motion to ReSchedule Proceedings Based on Good Cause and Motion to
Compel, in triplicate;
2. A certificate of mailing;
3. A stamped, self addressed postcard to acknowledge receipt.

Please charge Deposit Account No. 500209 for any additional fees which may be
required. Thank you for your assistance.

Very truly yours,

Tawnya Wojciechowski
for SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

Enclosures
W02-OC:NTW41364737.1



02-18-2005

U.S. Patent & TMO/TM Mail Rpt Dt. #64